

Application No.: 10/676,211

Reply to Office Action

REMARKS

Claims 1-20 and 22-24 are currently pending in this application. Of these, claims 1, 8, 14 and 22 are independent claims. Claims 1, 8, 14, and 22 have been amended herein for clarity without any addition of new matter. Claims 1-20 and 22 currently stand rejected as obvious in view of Webb (U.S. 2002/0143664). Claim 23 stands rejected as obvious in view of Webb, further in view of Robbins (U.S. 2002/0029386). Claim 24 stands rejected as obvious in view of Webb/Robbins, further in view of Liao (US 2003/0005466). Applicant respectfully notes that the rejections are improper for the following reasons and requests favorable reconsideration.

It goes without saying that a rejection under 35 U.S.C. §103 is improper if the suggested "obvious" modification of the art is not properly motivated. Examples of improper motivation include the present situation wherein the motivation for modification comes expressly and admittedly from the Applicant's own claims. *See* MPEP §2142 ("The tendency to resort to 'hindsight' based on applicant's disclosure is often difficult to avoid... However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.") (emphasis added). In summary, the use of applicant's own disclosure as a source of a teaching to combine is unmistakably improper.

In light of these foundational principles, consider specifically the pending rejections of independent claims 1, 8, 14, and 22. Each of these claims recites limitations pertaining to a system for processing a subscriber event for a mobile vehicle involving a telematics unit. The action cites Webb as allegedly teaching many elements of the claims, but the action admits that the important environment of a telematics system (and of course any specific aspect of such a system) is completely absent from Webb. According to the MPEP, a §103 rejection is improper in this situation unless the action can cite a teaching or motivation in the art, not the applicant's disclosure, that would make this missing aspect nonetheless obvious.

However, the teaching cited by the action is taken directly from the applicant's own claims! In particular, the action clarifies its cited motivation for modifying Webb as follows:

"Therefore, it is obvious [to make the alleged modification]...since it would be able to provide all the claimed functionalities."

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Action at page 3, lines 5-8 (emphasis added). There is thus no doubt that the action's motivation to make the asserted modification to Webb improperly comes from the applicant's own claims and not the prior art since the action expressly admits as much. Thus, the asserted modification of Webb to reject all claims under §103 is undeniably improper, and all pending rejections should be withdrawn.

Moreover, the references do not teach each element of the claims as required by law to support an obviousness rejection. For example, each claim as amended¹ requires that the notification transmission causes an action to be automatically executed. The action has cited Webb as teaching execution of an action in response to the notification. However, the teachings of Webb (gift reminders, links to vendors, etc.) cited at page 3 of the Office action do not pertain to automatically taking an action, but rather to an invitation to the user to take an action, which they may or may not take. Thus, this additional element is missing from the cited teachings as well. It is respectfully submitted that the rejections should for this reason as well be withdrawn.

Finally, the rejections in general appear to assert that a combination or modification is proper anytime there is some benefit to be derived from the combination/modification.² Although simple, this theory is legally and logically incorrect, and is so devoid of any actual standards that it could be used to cobble together any invention at all.

For example, imagine that the claims at issue additionally called for an eyebrow shaver laterally connected to the telematics unit. Under the Office action's "benefit" approach, I would simply pull up U.S. Design Pat. # D371,221 to Attaway ("Attaway") and state the following: "It would have been obvious to one of skill in the art to attach the shaver of Attaway laterally to the telematics unit of X-reference so the user would be able to accurately shave their eyebrows while driving." Of course, it's pretty clear that the prior art is not in the least bit teaching or suggesting the beneficial combination of an eyebrow shaver and telematics unit.

¹ The independent claims have been amended to clarify that the "action" in question is an automatic action, not a user initiated action.

² This rationale is used to create the asserted Webb modification (see, e.g., action, page 3), the asserted Webb/Robbins combination (action, page 9), and the asserted Webb/Robbins/Liao combination (action, page 10).

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All silly examples aside, the present Office action falls into exactly the same trap. Keep in mind that a §103 rejection based on a combination of references requires a motivation in the art, not just a restatement of the beneficial result that was foretold by the applicant's disclosure and claims. Thus, it is respectfully submitted that although the action alleges that combining various references to yield the invention would be beneficial, the action does not actually cite any motivation in the art to make that combination. Thus, for this additional reason, applicant respectfully requests favorable reconsideration of all claims.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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